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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/527,360

Applicant(s)

BUTTERFIELD, STUART

Examiner

JOSHUA MURDOUGH

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This action is responsive to Applicants' amendments received 2 June 2009.
2. This action has been assigned paper number 20090819 for reference purposes only.
3. Claims 1-20 are pending and have been examined.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-11 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 recites "instructions to record data to the selected portion of the memory device are effected by first means the interface" which makes the claim indefinite. The phrase "first means the interface" does not make sense in the context. The phrase appears to be missing one or more words or punctuation. Possible intended phrases include "a first means of the interface," "a first means being the interface," or "first means, the interface." As the phrase is subject to mutually exclusive interpretations, it is indefinite.
7. Claim 1 also recites "a second means used to initiate recordation of the data in a remainder of the memory device." However, it is unclear whether the claim element is a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph, because it does not expressly recite "means for" and it is not clear if "the memory device" is sufficient structure "to

initiate recordation of the data.” If applicant wishes to have the claim limitation treated under 35 U.S.C. § 112, sixth paragraph, applicant is required to:

(a) Amend the claim to include the phrase “means for” or “step for” in accordance with these guidelines: the phrase “means for” or “step for” must be modified by functional language *and* the phrase must **not** be modified by sufficient structure, material, or acts for performing the claimed function.

8. Claim 5 recites the limitation “the means for initiating the recording of data to the selected portion of the memory device” in lines 2-4. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 5 recites the limitation “means for initiating the recording of data to the selected portion of the memory device is embodied in a form of an emergency record button” which uses the phrase “means for” or “step for”, but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. § 112, sixth paragraph, because the phrase “embodied in a form” suggests the means could also be contained in the emergency record button and not the button itself. If Applicant wishes to have the claim limitation treated under 35 U.S.C. § 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

10. If Applicants do not wish to invoke 35 U.S.C. 112 6th paragraph in these claims, the Examiner recommends replacing “means” with words such as “component,” “device,” or

"apparatus." Applicants' specification should be reviewed to find the term(s) with the best support under 35 U.S.C. § 112 1st paragraph and antecedent support.

11. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 3-10, 12, 16, and 20, as understood by the Examiner are rejected under 35 U.S.C. §102(b) as being anticipated by Bergan (US 6,322,366).

14. As to claims 1 and 20, Bergan shows:

- a. An information recording apparatus comprising:
- b. a memory device **218** having a defined quantity of storage space (any storage medium can inherently only store a known amount of data), and
- c. an interface **206** for use by a user in initiating recording of data onto the memory device (C 13, LL 38-42)

- d. wherein a selected portion of the storage space of the memory device (location of the previous backup, CC 52-53, LL 48-26) is reserved for the recording of data in an emergency situation (a backup is for an emergency situation), and
 - e. the interface is configured such that instructions to record data to the selected portion of the memory device (Figure 138) are effected by first means the interface **3796**, the first means being separate from a second means **3460** used to initiate recordation of the data in a remainder of the memory device (Steps 3506 and 3508, Figure 129).
15. As to claim 12, Bergan shows:
- f. A method for storing a defined data item in an information recording apparatus comprising the acts of:
 - g. providing a first button **3796** for recording of the defined data item in a selected portion of a storage space (location of the previous backup, CC 52-53, LL 48-26) of a memory device (Figure 138);
 - h. providing a second button **3460** for recording of the defined data item in a remainder of the memory device (Steps 3506 and 3508, Figure 129);
 - i. activating the first button (Step 3804, Figure 138);
 - j. in response to the act of activating the first button, recording the defined data item onto the selected portion (Step 3818, Figure 138);
 - k. activating the second button (Step 3506, Figure 129); and
 - l. in response to the act of activating the second button, recording the defined data item onto a remainder portion of the memory device (Step 3508, Figure 129).

16. As to claim 3, Bergan further shows:

the information recording apparatus is selected from a music player, a music recorder, a digital camera, personal digital assistant (PDA), a personal computer (PCs) ("computer system," C 1, LL 13-15) or a digital telephone.

17. As to claim 4, Bergan further shows:

the interface is selected from a remote control handset, a control panel provided on a body of the apparatus or an on screen menu display 442 from which desired operations of the recording apparatus can be selected.

18. As to claim 5, Bergan further shows:

the means for initiating the recording of data to the selected portion of the memory device is embodied in a form of an emergency record button ("backup button," 3796).

19. As to claim 6, Bergan further shows:

the first means is in a form of an icon provided on a screen display 442.

20. As to claims 7 and 16, Bergan further shows:

an encoding device 222 for encoding the data to be stored in the selected portion.

21. As to claim 8, Bergan further shows:

the memory device comprises a CD **228**, DVD, mini-disc, digital tape or a hard disk **218**.

22. As to claim 9, Bergan further shows:

the apparatus further includes a controller **220** for managing storage and retrieval operations within the memory device.

23. As to claim 10, Bergan further shows:

the controller comprises a microprocessor **220** programmed to perform certain operations including storage and retrieval of data (C 13, LL 30-44).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 2, 13-15, and 19, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Bergan in view of Crocitti (US 2001/0006403).

26. As to claim 2, Bergan teaches as disclosed in regard to claim 1.

27. Bergan does not expressly teach:

the information recording apparatus is a digital video recording apparatus.

28. However, Crocitti teaches a digital video recording apparatus (“television receiver furnished with a memory,” [0005]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Bergan to process recorded video data instead of student data because regardless of the data people use, it is still beneficial to save that data and back it up when the user deems it to be sufficiently important.

29. As to claims 13-15, 18, and 19, Bergan teaches as disclosed in regard to claim 12.

30. Bergan does not expressly teach:

m. in response to the act of activating the first button, determining a space required for storing the defined data item;

n. checking a space available in the selected portion and if the available space is less than the space required for recording the defined data item, reorganizing pre-recorded data in the selected portion so as to provide the space required for storing the defined data item.

o. the act of reorganizing includes compressing the pre-recorded data stored in the selected portion;

p. the act of reorganizing includes deleting or overwriting the pre-recorded data;

q. deleting the pre-recorded data so as to create space in the selected portion; and

r. recording the defined data item onto the create space of the selected portion.

31. However, Crocitti teaches:

- s. in response to the act of activating the first button, determining a space required for storing the defined data item [0005];
 - t. checking a space available in the selected portion [0006] and if the available space is less than the space required for recording the defined data item, reorganizing pre-recorded data in the selected portion so as to provide the space required for storing the defined data item [0007].
 - u. the act of reorganizing includes compressing the pre-recorded data stored in the selected portion [0015].
 - v. the act of reorganizing includes deleting or overwriting the pre-recorded data [0030].
 - w. deleting the pre-recorded data so as to create space in the selected portion (Id.); and
 - x. recording the defined data item onto the create space of the selected portion (Id.).
32. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Bergan to include the memory management and reorganization as taught by Crocitti in order to more efficiently use the available memory.
33. Crocitti does not teach:
- y. if the available space is less than the required size, then performing the acts of:
 - z. locating the selected portion of the memory device;
 - aa. downloading the defined data item from a source; and
 - bb. recording the defined data item onto the selected portion.

34. However, Bergan teaches that there is enough space, so these steps would not be performed and therefore are not needed for anticipation/infringement. The Examiner takes the same position with respect to the reorganization steps above, but has cited the pertinent sections of the reference for them for Applicants' convenience.

35. Claims 11 and 17 rejected under 35 U.S.C. §103(a) as being unpatentable over Bergan in view of the "Federal Student Aid Handbook".

36. Bergan teaches as disclosed in regards to claims 9 and 17.

37. Bergan does not expressly show:

cc. the controller is configured to carry out financial transactions between a user of the information recording apparatus and a supplier of data to be recorded, or a supplier of emergency memory in the selected portion of the memory device; or

dd. receiving authorization for payment of a fee by a user of the information recording apparatus and in response, decrypting the defined data item.

38. However the "Federal Student Aid Handbook" teaches the withholding of transcripts of students that are in default or owe an overpayment (Page 1-69, Financial Aid History, Paragraph 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Bergan to add consideration of a student's financial standing with the school before releasing the grade data because of the federal guidance from the Department of Education to do so (Page 1-74, Paragraph 1.

39. Claims 1, 3-10, and 20, as understood by the Examiner, are alternatively rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergan in view of Official Notice.

40. It is the Examiner's principle position that "a memory device having a defined quantity of storage space" is inherent to any memory device. However, if a reviewing body determines this not to be inherent, it is the Examiner's secondary position that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Bergan to use a memory device having a defined quantity of storage space as set forth below. This alternate rejection is provided in accordance with MPEP § 2112 III..

41. As to claims 1 and 20, Bergan shows:

ee. An information recording apparatus comprising:

ff. a memory device **218**, and

gg. an interface **206** for use by a user in initiating recording of data onto the memory device (C 13, LL 38-42)

hh. wherein a selected portion of the storage space of the memory device (location of the previous backup, CC 52-53, LL 48-26) is reserved for the recording of data in an emergency situation (a backup is for an emergency situation), and

ii. the interface is configured such that instructions to record data to the selected portion of the memory device (Figure 138) are effected by first means the interface **3796**, the first means being separate from a second means **3460** used to initiate recordation of the data in a remainder of the memory device (Steps 3506 and 3508, Figure 129).

42. Bergan does not expressly show:

the memory device having a defined quantity of storage space.

43. However, the Examiner takes Official Notice that it is notoriously old and well known in the art for a memory device having a defined quantity of storage space. Because computers are digital devices they operate on discrete values (1's and 0's). Each value takes a known amount of space on the medium to be stored. Any medium only contains a definite amount of space in which to store the values. Because the space to store all the values is limited and the space to store each value is known, the maximum number of values that can be stored is also known. Moreover, memory devices are sold according to the amount of storage space they contain (*e.g.* the 4.7 GB DVD-RAM disc cited in the previous action). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Bergan to use a memory with a defined quantity of storage space in order to know that it has enough storage space to store the expected data.

44. As to claim 3, Bergan further shows:

the information recording apparatus is selected from a music player, a music recorder, a digital camera, personal digital assistant (PDA), a personal computer (PCs) ("computer system," C 1, LL 13-15) or a digital telephone.

45. As to claim 4, Bergan further shows:

the interface is selected from a remote control handset, a control panel provided on a body of the apparatus or an on screen menu display 442 from which desired operations of the recording apparatus can be selected.

46. As to claim 5, Bergan further shows:

the means for initiating the recording of data to the selected portion of the memory device is embodied in a form of an emergency record button ("backup button," 3796).

47. As to claim 6, Bergan further shows:

the first means is in a form of an icon provided on a screen display **442**.

48. As to claim 7, Bergan further shows:

an encoding device **222** for encoding the data to be stored in the selected portion.

49. As to claim 8, Bergan further shows:

the memory device comprises a CD **228**, DVD, mini-disc, digital tape or a hard disk **218**.

50. As to claim 9, Bergan further shows:

the apparatus further includes a controller **220** for managing storage and retrieval operations within the memory device.

51. As to claim 10, Bergan further shows:

the controller comprises a microprocessor 220 programmed to perform certain operations including storage and retrieval of data (C 13, LL 30-44).

Means Phrases

52. As the invocation of 35 U.S.C. 112 6th paragraph can drastically alter the interpretation of a claim, the Examiner has addressed the following limitations due to their potential to invoke 112 6th paragraph.

53. Claim 1 sets forth the following phrases:

jj. “first means the interface;”

kk. “the first means being separate from a second means;” and

ll. “a second means used to initiate recordation of the data in a remainder of the memory device.”

54. In each instance, the claim fails to recite the phrase “means for” or “step for.” According to the first prong of the three prong analysis in MPEP § 2181 I., one of the requirements for invoking 112 6th paragraph is the recitation of “step for” or “means for.” Because these phrases do not recite “step for” or “means for” they do not invoke interpretation under 112 6th paragraph.

55. Claim 5 sets forth the following phrase:

mm. “the means for initiating the recording of data to the selected portion of the memory device is embodied in a form of an emergency record button.”

56. This phrase sets out the means as being embodied in the form of an emergency record button. According to the third prong of the three prong analysis in MPEP § 2181 I., the “means

for” or “step for” must not be modified by sufficient structure, material, or acts for achieving the specified function. As Applicants have set forth the emergency record button as the means, this phrase does not invoke interpretation under 112 6th paragraph.

57. Claim 6 sets forth the following phrase:

nn. “the first means is in a form of an icon provided on a screen display.”

58. This phrase does not recite “means for” or “step for.” According to Prong (A) of the three prong analysis in MPEP § 2181 I., one of the requirements for invoking 112 6th paragraph is the recitation of “step for” or “means for.” Because this phrase does not recite “step for” or “means for” it does not invoke interpretation under 112 6th paragraph.

59. The Examiner concludes that interpretation under 35 U.S.C. 112 6th paragraph is not invoked for any of the presently presented claims.

Response to Arguments

60. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

61. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the reference *How Computers Work Millennium Ed.* by Ron White; is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The reference is cited in its entirety. Moreover, because this reference is directed

towards beginners (see e.g. "User Level Beginning . . ."), because of the reference's basic content (which is self-evident upon review of the reference), and after further review of the entire application and all the art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that this reference is primarily directed towards those of low skill in this art. Because this reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within this reference.

Conclusion

62. Applicant's amendment filed June 6, 2009 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

63. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621